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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,663	08/29/2001	Akiko Sato	NITT.0031	4771
38327	7590	11/10/2004	EXAMINER	
REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			TANG, KUO LIANG J	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/940,663	SATO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kuo-Liang J Tang	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 August 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 13-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. This Office Action is in response to the amendment filed on 8/24/2004.

Priority date is 11/09/2000.

Claims 1-12 are cancelled. Claims 13-21 are pending.

#### *Response to Arguments*

2. Applicant's arguments with respect to claims 13-21 have been considered but are moot in view of the new ground(s) of rejection.

Claims 13-21 remain rejected under 35 U.S.C. §102(e) as being anticipated by Hohle.

*In the remarks, the applicant argues that:*

Applicant argues that Hohle does not disclose, teach or suggest a message ID that is used when exchanging the application loading permission and for claim 13 and 19, the data of the smart card is stored using the message ID as a key and search the result using the message ID as a key (see RE page 9, first 2 paragraphs).

#### **Examiner's response:**

The examiner disagrees with Applicant's assertion that that Hohle does not disclose, teach or suggest a message ID. In fact, Hohle does teaches initialization data (e.g. account number, serial number, default preferences, and the like) (emphasis added)(E.g. see col. 3:57-67) which is the same as the message ID in this application. These data can be used to stored and searched as a key.

***Claim Objections***

3. Claims 16 and 19 are objected to because of the following informalities:

Claim 16, line 2, “connected” should be “connect”

Claim 19, line 2, “connected” should be “connect”

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 13-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hohle US Patent No. 6,199,762.

As Per Claim 13, Hohle teaches that a system generally for personalizing and synchronizing smartcard data in the context of a distributed transaction system is disclosed. A dynamic smartcard synchronization system comprises access points configured to initiate a transaction in conjunction with a smartcard, an enterprise data collection unit, and a card object database update system. CODUS interfaces with personalization system in order to facilitate reissuance of the card by providing updated data in the event a card is destroyed, lost, or stolen.

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(E.g. see Abstract and associated text). In that Hohle discloses the method that covering the steps of a smart card system, comprising:

“a smart card issuance/management system configured to perform issuance and management of a smart card (e.g. see FIG.9, card management system 902 and associated text”;  
and

“a smart card service providing/managing system configured to perform issuance and management of an application loaded on the smart card, wherein  
the smart card issuance/management system and the smart card service  
providing/managing system are operatively connected to each other through a network (e.g. see  
FIG. 1, enterprise networks 114 and associated text) such that information exchange is achieved  
by transmitting and receiving electronic messages through the network,

each of the electronic messages is uniquely identified using a message ID (e.g. see col.  
3:61-62, initialization data (e.g., account numbers, serial numbers, default preferences, an the  
like)),

data of the smart card issuance/management system and the smart card service  
providing/managing system is stored using the message ID as a key (e.g. see col. 3:61-62,  
initialization data (e.g., account numbers)), and

the information exchange between the smart card issuance/management system and the  
smart card service providing/managing system includes

at the time of initial issuance of the smart card, the smart card issuance/management  
system sending an application loading permission which permits the smart card service

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providing/management system to load an application (e.g. see FIG. 9 and associated text, i.e. see col. 3:57-67),

at the time of reissuance of the smart card, the smart card issuance/management system searches the message ID of the application loading permission using card attribute data, which identifies the smart card and sends the message ID of the application loading permission (e.g. see col. 9:57-65 and see FIG. 9 and associated text, i.e. see col. 3:57-67),

at the-time of the initial issuance of the smart card, the smart card service providing/managing system sends the application loading permission and the application and loads the application in the smart card (e.g. see col. 9:57-65 and see FIG. 9 and associated text, i.e. see col. 3:57-67), and

at the time of the reissuance of the smart card, the smart card service providing/managing system receives the card attribute data from the smart card, sends the card attribute information and an application ID of the application to the smart card issuance/management system, and searches an examination result at the time of initial loading application using the message ID as the key (e.g. see col. 9:57-65 and see FIG. 9 and associated text, i.e. see col. 3:57-67)".

As Per claim 14, the rejection of claim 13 is incorporated and further Hohle teaches:

"wherein the message ID is at least one of a company identification data of the card issuer , a company identification data of the service provider, and a sequence number of the electric message in combination (e.g. see col. 3:61-62, initialization data (e.g., account numbers, serial numbers, default preferences, an the like))".

As Per claim 15, the rejection of claim 13 is incorporated and further Hohle teaches:

“wherein the card attribute data is a card ID encrypted using a card issuer's own public key (e.g. see FIG. 9, key systems 920, CCSS 916 and associated text, i.e. see col. 10:59-64)”.

As Per Claim 16, Hohle teaches a smart card issuance/management system configured to perform issuance and management of a smart card and configured to connect to a smart card service providing/managing system through a network, wherein

“information exchange is achieved by transmitting and receiving electronic messages through the network (e.g. see FIG. 1, enterprise networks 114 and associated text)”;

“each of the electronic messages is uniquely identified using a message ID(e.g. see col. 3:61-62, initialization data (e.g., account numbers, serial numbers, default preferences, an the like))”;

“data of the smart card issuance/management system and the smart card service providing/managing system is stored using the message ID as a key (e.g. see col. 3:61-62, initialization data (e.g., account numbers))”;

“at the time of initial issuance of the smart card, the smart card issuance/management system sends an application loading permission which permits the smart card service providing/managing system to load an application (e.g. see col. 9:57-65 and see FIG. 9 and associated text, i.e. see col. 3:57-67)”; and

“at the time of reissuance of the smart card, the smart card issuance/management system searches a message ID of the application loading permission using card attribute data, which identifies the smart card, as a key, and sends the message ID of the application loading permission (e.g. see col. 9:57-65 and see FIG. 9 and associated text, i.e. see col. 3:57-67)”.

As per Claims 17-18, the rejection of claim 16 are incorporated and are rejected under the same reason set forth in connection of the rejection of claims 14-15 respectfully.

As Per Claim 19, Hohle teaches a smart card service providing/managing system configured to perform issuance and management of a smart card and configured to connect to an IC card service issuance/management system configured to perform issuance and management an application loaded on the smart card, through the network, wherein “information exchange is achieved by transmitting and receiving electronic messages through the network (e.g. see FIG. 1, enterprise networks 114 and associated text)”; “each of the electric messages is uniquely identified using a message ID (e.g. see col. 3:61-62, initialization data (e.g., account numbers, serial numbers, default preferences, an the like))”;

“the data of the smart card issuance/management system and the smart card service providing/managing system is stored using the message ID as a key (e.g. see col. 3:61-62, initialization data (e.g., account numbers))”;

“at the time of initial issuance of the smart card, the smart card service providing/managing system receives an application loading permission from the smart card issuance/management system, which permits the smart card service providing/management system to load an application, and loads the application to the smart card (e.g. see col. 9:57-65 and see FIG. 9 and associated text, i.e. see col. 3:57-67)”; and

“at the time of reissuance of the smart card, the service providing/managing system receives the card attribute data from the smart card which identifies the smart card, sends the card attribute data and an application ID of the application, receives the message ID of the application loading permission, and searches an examination result at the time of initial loading application using the message ID as the key (e.g. see col. 9:57-65 and see FIG. 9 and associated text, i.e. see col. 3:57-67)”.

As per Claims 20-21, the rejection of claim 19 are incorporated and are rejected under the same reason set forth in connection of the rejection of claims 14-15 respectfully.

*Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Correspondence Information***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang J Tang whose telephone number is 703-305-4866. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on 703-305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

After October 25, 2004, examiner can be reached at new telephone number (571) 272-3705, and the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Kuo-Liang J. Tang*

Software Engineer Patent Examiner

*Kuangm Anthony Nguyen-Ba*

ANTONY NGUYEN-BA  
PRIMARY EXAMINER